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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,992	12/05/2001	Ritsuko Tanaka	1086.1152	2820

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EXAMINER

RETTA, YEHDEGA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,992

Applicant(s)

TANAKA ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed March 7, 2005. Applicant amended claims 1, 2, 18-22, added claim 23. Claims 1-23 are currently pending.

Claim Objections

Claim 23 is objected to because of the following informalities: The status of the claim should indicate "currently amended" instead of "previously presented" since applicant amended the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 recites the limitation "makes a link to the publicized web page of the advertiser". There is insufficient antecedent basis for this limitation in the claim. Claim 1 does not recite publicized web page of the advertiser.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5, 7-10, 16, 18-24 are rejected under 35 U.S.C. 102(B) as being anticipated by NAA @ Presstime: NEXPO'97 Report, <http://www.naa.org/presstime/97nexpo/nexad.html> (hereinafter NEXPO'97).

Regarding claims 1-4 and 18-23 NEXPO'97 teaches a database, which registers a supplier for providing a first service (access to a newspaper) and users (advertisers) that have contracts with the supplier (newspaper publisher) (see page 4, Gannet newspapers); and advertisement preparation unit for placing the advertisement on a web page (page 3-8). NEXPO'97 teaches allowing advertisers to create, schedule and insert ads for print (different medium for the first service (web page) allowing the user to view (edit) the advertisement on the web page (see col. 8 line 45 to col. 9 line 17 col. 13 line 29 to col. 14 line 16). NEXPO'97 teaches wherein the second service (advertisement) provided to the user at an independent time (different time than it was prepared or placed on the web site) and by a different medium (for print, audiotex and www, see page 5) from the first service (ad placing web page).

Regarding claims 5, 7-10, NEXPO'97 teaches giving a privilege offered by a newspaper dealer or an advertiser to user (realtors, auto dealers, recruiters, ad-agency workers) viewing the advertisement; making a link to the web page; making access to a web page of the advertiser managed by a newspaper dealer (Gannett newspapers using Celebro advertising system); stores advertisement selection information specified by a user (gives advertisers option for reusing their ad data) and automatically edits a web page dedicated to the user and storing the resulting data; allowing the user to visit the page (see page 4 and 5)).

Regarding claim 16, NEXPO'97 teaches printing the advertisement placed on the web page on paper media and distributing the advertisement (see page 4).

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Regarding claim 24, NEXPO'97 teaches a database, which registers a supplier for providing a first service (access to a newspaper) and users (advertisers) that have contracts with the supplier (newspaper publisher) (see page 4, Gannet newspapers); and advertisement preparation unit for placing the advertisement on a web page (page 3-8). NEXPO'97 teaches allowing advertisers to create, schedule and insert ads for print (different medium for the first service (web page) allowing the user to view (edit) the advertisement on the web page (see col. 8 line 45 to col. 9 line 17 col. 13 line 29 to col. 14 line 16).

Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Reilly (US 5,740,549).

Regarding claim 25, Reilly teaches providing a first service to users and registering users of the first service (access to a newspaper) (see col. 7 lines 45-56); creating advertisement and displaying the advertisement only to registered users (see col. 8 lines 45-67 and col. 13 lines 60 to col. 14 lines 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAA

® Presstime: NEXPO'97 Report, <http://www.naa.org/presstime/97nexpo/nexad.html>

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(hereinafter NEXPO'97) further in view of Fredrickson Pub. No. US 2002/0019768 (hereinafter Fredrickson).

Regarding claim 6, NEXPO'97 does not teach delivering an advertisement corresponding to the advertisement selection information by mail or facsimile. Fredrickson teaches sending information corresponding to advertisement by mail or facsimile. It would have been obvious to one of ordinary skill in the art at the time of the invention to send the information based upon user's (advertiser's) preference of media environment, as taught in Fredrickson (see page 3 [0055]).

Regarding claim 11, NEXPO'97 teaches the system allows advertiser to create ads for print, audiotex and WWW, however is silent to placing local information other than advertisement and publicizing the information to the users. Fredrickson teaches placing local information other than advertisement, such as link collections and publicizing the information to the users (see [0051, 0055, 0069, 0090]). It would have been obvious to one of ordinary skill in the art at the time of the invention to place information such as links in order to provide advertisers with link to different media environment as taught in Fredrickson.

Regarding claim 17, Fredrickson teaches collecting registers visiting information of the user for each advertisement visit and determines and settles publication fee based upon the results of the survey (see 0050, 0065, 0066, 0067 and 0068-0086). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such feature, in NEXPO' 97, in order to charge advertisers based on the visits, as taught in Fredrickson.

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Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAA ® Presstime: NEXPO'97 Report, <http://www.naa.org/presstime/97nexpo/nexad.html> (hereinafter NEXPO'97) further in view of Official Notice.

Regarding claim 12 NEXPO'97 does not teach providing an application page for subscribing to the newspaper. It is well known in the art of online publication to provide an application page for subscribers to the newspaper if they are not already registered. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide registration page for the intended use of identifying subscribers.

Regarding claim 13, NEXPO'97 teaches providing contractors (advertisers) access to the web page for placing ads, however failed to explicitly disclose displaying the necessity of updating the contract at the time of visiting the web page. Official Notice is taken that is well known in the art at the time of the invention to display contract renewal form if the contract is to expire. It would have been obvious to one of ordinary skill in the art at the time of the invention for NEXPO'97 to provide such form in order to allow the advertiser with the option to renew the contract of placing ads.

Regarding claim 14 NEXPO'97 does not teach preparation of a guide map upon a request from the user. Official Notice is taken that is old and well known in the art of WWW to provide a preparation of a guide map and to display it. On-line advertisers provide a program such as Mapquest to provide a map of a location, including the current location of the user and the destination specified by the user, in order to find the geographical location of the advertiser. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide

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such feature, in NEXPO'97's web page, since Internet users use on-line map, such as Mapquest, to find the location of the advertiser providing the advertisement.

Regarding claim 15, NEXPO'97 does not teach providing an order request for advertised commodity. It is also well known to providing an order request for advertised commodity after user access advertisers web page and delivering the ordered product. It would have been obvious to one of ordinary skill in the art at the time of the invention to include such feature in order to allow user the option of making a purchase of the advertised products from the advertiser.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments in regard to NEXPO'97 have been considered but they are not persuasive. Examiner does not agree with Applicant's in regard to the NEXPO'97 argument. The NEXPO'97 article clearly teaches advertisement preparation unit for preparing an advertisement requested by an advertiser. The article teaches a system that allow Realtors, auto dealers, recruiters, ad agency workers and even undertakers to create, schedule and insert ads (see page 3 last paragraph) and on page 4, the article teaches the "permit advertisers to take information directly from databases, such as multiple-listing real-estate services or auto-dealer inventories". Further teaches "(t)hey turn the text and photos into newspaper ads, with insertion orders and prices, to newspaper's ad databases." The article also teaches putting advertisers in control reduces errors, automatic transmission cuts need for sales clerks and order-takers, and using newspaper-supplied ad templates simplifies production and abbreviated deadlines. If that is not advertisement preparation unit for preparing an

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advertisement requested by an advertiser, applicant needs to clearly claim applicant's invention of advertisement preparation unit.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR


RETTA YEHDEGA
PRIMARY EXAMINER